



08 SEP 2002

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James LaBarre
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Arlington, VA 22313-1404

In re Application of
BERTRAND, Pierre
U.S. Application No.: 09/807,885
PCT No.: PCT/FR00/01263
Int. Filing Date: 11 May 2000
Priority Date: 12 May 1999
Attorney's Docket No.: 032326-170
For: METHOD FOR PRODUCING A
CONTACTLESS CARD

DECISION

The decision is in response to the "PETITION UNDER 37 C.F.R. §1.47(b)" ("Pet.") submitted on 20 November 2001 requesting that the United States Patent and Trademark Office (USPTO) accept a declaration without the signature of the sole inventor.

BACKGROUND

On 11 May 2000, petitioner filed international application PCT/FR00/01263 claiming priority to a French patent application filed 12 May 1999. A copy of the international application was communicated from the International Bureau to the USPTO on 23 November 2000.

On 12 December 2000, a Demand was filed with the International Preliminary Examination Authority electing the United States. The election was made prior to the expiration of 19 months from the priority date. Accordingly, the deadline for submission of a copy of the international application and payment of the basic national fee was extended to expire thirty months from the priority date, *i.e.*, 13 November 2001 (12 November 2001 was a holiday).

On 13 November 2001, petitioner filed a transmittal letter for entry into the national stage in the United States under 35 U.S.C. 371 which was accompanied by, *inter alia*, a check to pay the basic national fee.

On 17 January 2002, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee of \$130.00 was required. Petitioner was given two-months to respond with extensions of time available.

On 12 July 2002, petitioner submitted the instant petition under 37 CFR 1.47(b) which was accompanied by, *inter alia*, a four-month extension and fee; a declaration of Maguie Donnini ("Donnini Decl."); the petition fee of \$130.00; a declaration of Emilien Milharo ("Milharo Decl."); a Combined Declaration and Power of Attorney executed by Bernard Nonnenmacher, Director of Intellectual Property of Gemplus on behalf of the sole inventor; a copy of an employment agreement ("Agreement") with an English translation of a section; and copies of various letters and documents in the French language.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the requisite petition fee, (2) factual proof that the inventors cannot be reached after diligent effort, (3) a statement of the last known address of the inventors, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventors, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

The appropriate petition fee has been paid. Item (1) is complete.

Concerning item (3), the last known addresses of the sole inventor, Pierre Bertrand was listed as:

"La Caravalle"
13, rue Alexandre Rossat
13200 Cassis,
France

Regarding item (4), the 37 CFR 1.47(b) applicant included a Declaration signed by Bernard Nonnenmacher, Director of Intellectual Property of Gemplus, the 37 CFR 1.47(b) applicant. Director is a position recognized as having the authority to sign for a foreign corporation. The declaration included the sole inventor's name, last known address, residence and citizenship and is in compliance with 37 CFR 1.497(a) and (b). Therefore, item (4) is satisfied.

With regard to item (5), section 409.03(f) of the Manual of Patent Examining Procedure (MPEP), *Proof of Proprietary Interest*, states, in part:

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent

on certain specified conditions being met, it must be established by a statement of facts by someone with first hand knowledge of the circumstances in which those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by a statement of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

In this case, the 37 CFR 1.47(b) applicant included a declaration by Emilien Milharo who works as Patent Engineer in the Intellectual Property Department of the 37 CFR 1.47(b) applicant and declares that he "discussed the invention with Pierre Bertrand, and can confirm that it was made by him within the scope of his duties at Gemplus." Milharo Decl. at # 3. Further, Mr. Milharo states that the invention was "made while he was an employee of Gemplus." *Id.* at # 4. The 37 CFR 1.47(b) applicant also submitted a copy of an employment agreement purportedly signed by the sole inventor. The Agreement submitted was in the French language but petitioner included an English translation of the "Patents and Inventions" section of the agreement. This section states, in part that "all inventions, patentable or not, made by the holder of this contract, either within his/her regular duties or a particular mission he/she is in charge of, will remain the property of the Company."

This evidence satisfies the requirements in item (5) above.

Regarding item (6), section 409.03(g) of the MPEP, *Proof of Irreparable Damage*, states that "[i]rreparable damage may be established by a showing (a statement) that a filing date is necessary to preserve the rights of the party or to prevent irreparable damage."

Here, irreparable damage appears to be alleged via the statement that "the filing of this application and petition are necessary to preserve the national phase rights of Gemplus in the United States accruing from International Application No. PCT/FR00/01263." Pet. at # 4. This statement is sufficient to satisfy item (6).

Therefore, the 37 CFR 1.47(b) applicant has satisfied items (1), (3), (4), (5) and (6) in this petition.

However, the 37 CFR 1.47(b) applicant failed to satisfy item (2). The 37 CFR 1.47(b) applicant claims that "the sole inventor is unavailable." *Id.* at ¶ 1. The burden in asserting this claim is outlined in section 409.03(d) of MPEP, *Proof of Unavailability or Refusal*, which states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made . . .

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included [in a] statement of facts. It is important that the statement contain facts as opposed to conclusions.

Here, petitioner included a declaration by Mr. Donnini who states that he "has first-hand knowledge of the facts described in this Declaration." Donnini Decl. at # 1. Mr. Donnini declares that "[o]n September 7, 2001, a registered letter was sent from Gemplus Intellectual Property Department to the inventor, Pierre Bertrand, at his last known address, forwarding a Declaration to be signed for the U.S. patent application corresponding to PCT/FR00/01263." *Id.* at # 2. After no response was received, Mr. Donnini sent another registered letter to the same address and claims that the "letter was returned unopened, a week later, bearing a notation that the inventor no longer lived at that address." *Id.* at # 3. Mr. Donnini also claims that he tried to obtain the telephone number in the city of his last known address of the sole inventor using a telephone book and the internet, but "there is no listing for the inventor." *Id.* at # 4.

These statements of the actions taken by the 37 CFR 1.47(b) applicant are sufficient to prove that 'a diligent effort' was made to contact the sole inventor if accompanied by the requisite documentary evidence. However, the 37 CFR 1.47(b) applicant submitted what purportedly are copies of the documentary evidence to prove the facts described by Mr. Donnini are accurate. However, these documents are all in a foreign language. The USPTO does not accept foreign language documents as evidence without an accompanying English translation. In addition, it also appears that the 37 CFR 1.47(b) applicant did not provide any evidence of an internet search performed.


For these reasons, item (2) is not satisfied.

CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



Richard Cole
PCT Legal Examiner
PCT Legal Office



James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457